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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,884	11/17/2003	Colin Waters	16793-002001	5282
20985	7590	08/27/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			TA, THO DAC	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,884

Applicant(s)

WATERS ET AL.

Examiner

Tho D. Ta

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figures 1A-1D should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the blocked location" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said second specified portion" in lines 11 and 12. There is insufficient antecedent basis for this limitation in the claim. For purpose of examination, Examiner assumes that "the second specified portion" as "the specified portion which is blocked".

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindeberg et al. (5,178,561).

In regard to claim 1, Lindeberg et al. discloses a method, comprising: marking a first portion (left side of Fig. 3) of a first connector 10 used to supply a first type of electricity, by blocking one of the pins of the first connector 10; marking a corresponding location of a second connector (mating connector is not shown, it is inherent) which mates with the first connector 10, but is used with a second type of electricity, which is incompatible with the first type of electricity, by forming a protruding portion (the pin contact from the mating connector) in a corresponding area to the blocked location 7, thereby preventing the second connector used for the second type of electricity from being inserted into the first connector 10 used for the first type of electricity.

In regard to claims 2, 3, 8, the recitations regarding voltage have not been given significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regard to claim 4, Lindeberg et al. discloses that each of the first and second connectors have a plurality of pins, and where the first connector 10 is a female connector and the second connector is a male connector.

In regard to claim 6, Lindeberg et al. discloses that each of the first and second connectors have a spare pin (7 for first connector 10) which is not used for electrical connection, and the first portion 2 of the first connector 10 and the corresponding portion (the contact of the mating connector) of the second connector use an area of the spare pin (see fig. 3).

In regard to claim 10, Lindeberg et al. discloses that marking a first portion of a third connector (which is the connector 10 when insulating plus 1 and 3 are used) used to supply a lower voltage with a corresponding female pin, which mates with the protruding portion (the pin contact from the mating connector). The recitation regarding voltage has not been given significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

6. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Dillan (4,386,333).

In regard to claim 11, Dillan discloses a method, comprising: forming a first version of a first connector (Fig. 1C with 230 VAC) intended for use with a higher voltage, having a specified portion which is blocked (blocked by 110); forming a second version of the first connector (Fig. 1C with 230 VAC), intended for use with a higher voltage, having the specified portion 112 which is open; and forming a first version of a second connector (fig. 5) that mates with the first connector, and is intended for use with the lower voltage (115 VAC), and which has a portion 510 that protrudes in a location corresponding the second specified portion.

In regard to claim 12, Dillan discloses forming a second version (fig. 6) of the second connector that is intended for use with the higher voltage (230 VAC), and does not have the protruding portion 510.

In regard to claim 13, Dillan discloses a connector, comprising: a first version (Fig. 1C with 230VAC) of a connector of a first specified form factor, intended for use with a first kind of electricity; a second version (Fig. 1C with 115 VAC) of the connector of the first specified form factor, intended for use with a second kind of electricity that is incompatible with the first kind of electricity; and a physical blocking part 112, inserted into a position of a pin of the connector 103, that prevents a connector for the first kind of electricity from being used with a mating connector (fig. 5) for the second kind of electricity.

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In regard to claim 14, Dillan discloses where the first kind of electricity is a higher voltage, and the second kind of electricity is a lower voltage.

In regard to claim 15, the recitation regarding voltage has not been given significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindeberg et al..

In regard to claim 5, Lindeberg et al. does not disclose that each of the first and the second connectors having 19 pins. It would have been obvious to add more pins to each of the first and the second connectors, while the additional pins undoubtedly made it versatile, such a modification would have involved a mere change in the number of the parts. Duplication of parts for a multiplied effect is generally recognized as being within the level of ordinary skill in the art. St Regis Paper Co. V. Bemis Co., Inc., 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977).

***Allowable Subject Matter***

9. Claims 7 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: In regard to claim 7, the combination of the base claim and any intervening claims with the connector is substantially round, and the spare pin is in the center would render the claims unobvious over the prior art. In regard to claim 9, the combination of the base claim and any intervening claims with the marking comprises inserting a pin into the second connector in a spot corresponding to the area, to cause the location of the second connector to protrude from the area would render the claims unobvious over the prior art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**THO D. TA**  
**PRIMARY EXAMINER**

tdt  
08/25/04